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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,642	12/09/1999	RICHARD S. SCHWERDTFEGER	AUS990817US1	9110

35617 7590 04/09/2003

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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 04/09/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/458,642

Applicant(s)

SCHWERDTFEGER ET AL.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13, 17-22 and 28-30 is/are allowed.
- 6) ☒ Claim(s) 1-8, 14, 16 and 23-27 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Response

1. The response filed on 11/26/2002 has been entered and made of record.
2. Original claims 1-30 are pending
3. Applicant's arguments with respect to claims 1-8, 14, 16 and 23-27 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

4. Claims 9-13 and 17-22, 28-30 are allowed.
5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-8, 14, 16 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by

Bakshi et al., U.S. Patent No. 6,311,215.

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As per claims 1 and 23, Bakshi et al., disclose a system for delivering an electronic document, comprising:

a transcoder proxy (34) coupled to receive the electronic document in a first digital format, wherein the electronic document includes an element, and wherein a JAVASCRIPT event is associated with the element, and wherein the element includes JAVASCRIPT code executed in response to the JAVASCRIPT event (see col. 3, lines 30-65), and wherein the transcoder proxy is configured to:

assign a unique identifier to the element (storing the data elements, inherently including unique identifier, see also col. 4, lines 18-59);

form a model of a logical structure of the electronic document (see fig. 2, and col. 4, lines 31-59);

use the model to produce an original script that includes: (I) at least a portion of the electronic document expressed in a second digital format, and (ii) the element and the identifier assigned to the element (see col. 3, line 30 to col. 4, line 59); and

a client machine (12) coupled to receive the original script (see col. 3, line 30 to col. 4, line 59).

In considering claim 2, Bakshi et al., disclose a system, wherein the client machine is configured to:

use the original script to present the portion of the electronic document;

associate the JAVASCRIPT event with the element (see col. 7, lines 4 to col. 8, line 51);

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generate the JAVASCRIPT event in response to user input (see col. 7, lines 4 to col. 8, line 51); and

provide JAVASCRIPT event information and the identifier assigned to the element associated with the JAVASCRIPT event to the transcoder proxy (see col. 7, lines 4 to col. 8, line 51).

In considering claims 3-4, and 24-25, accessing and manipulating the document is inherent to Bakshi's system.

In considering claims 5-6 and 26-27, Bakshi et al., disclose a system, wherein the first digital format is a text-based markup language such as HTML or XML (see col. 4, lines 31-60).

In considering claims 7 and 8, Bakshi et al., disclose a system, wherein elements of the electronic document are associated with corresponding identifiers within the model, and wherein in response to the JAVASCRIPT event and the identifier provided by the client machine, the transcoder proxy is configured to:

access the element within the model using the identifier (see col. 7, lines 4 to col. 8, line 51);

execute the JAVASCRIPT code, thereby producing a result (see col. 7, lines 4 to col. 8, line 51);

use the model and the result to produce a modification script, wherein the modification script differs from the original script (see col. 7, lines 4 to col. 8, line 51);
and

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provide the modification script to the client machine (see col. 7, lines 4 to col. 8, line 51).

In considering claims 14 and 16, Bakshi et al., disclose a client system, comprising

an output device (see fig. 4, element 12); and

a user agent (48) coupled to the output device and adapted for coupling to a transcoder proxy (34), wherein the user agent is configured to:

receive an original script from the transcoder proxy, wherein the original script includes an element and an identifier assigned to the element (see fig. 4, and col 8, lines 19- 64 and col. 4, lines 17-60); and
form a transcoded document in response to the original script, wherein the transcoded document is a representation of the portion of the electronic document (see fig. 4, and col 8, lines 19- 64 and col. 4, lines 17-60).

CONCLUSION

8. The prior art made of record and relied upon is considered pertinent to the applicants disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Etienne, Ario** can be reached at **(703)308-7562**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)305-3900**.

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10. Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 746-7238, (after final communications)

(703) 746-7239, (Official communications)

(703) 746-7240, (Non-Official/Draft).

As

4/5/2003



SALEH NAJJAR
PRIMARY EXAMINER